

REMARKS

Reconsideration is requested in view of the above amendment and the following remarks. New claim 26 is added. Claims 1-18, 21, and 24-26 are pending.

Entry of claim 26 is requested as it would not raise new issues and require further consideration. Claim 26 contains many of the same limitations recited in claim 1, and additionally recites that the abrading surface comprises an irregular texture. This language is supported by the original disclosure, for example Figures 2-4 which illustrate the abrading surface 4 as being irregular in texture.

In the action, claims 1, 3, 6, 8-10, 21 and 24-25 are rejected under 35 USC 103(a) as being unpatentable over Switzerland CH 237277 and US 1,907,196 to Aitken. This rejection is respectfully traversed and reconsideration is requested in view of the following comments.

In addition, claims 2, 4-5 and 7 are rejected under 35 USC 103(a) as being unpatentable over Switzerland CH 237277, US 1,907,196 to Aitken, and US 6,145,512 to Daley. This rejection is respectfully traversed and reconsideration is requested in view of the following comments.

Further, claim 11 is rejected under 35 USC 103(a) as being unpatentable over Switzerland CH 237277, US 1,907,196 to Aitken, and US 5,361,786 to Pangburn. This rejection is respectfully traversed and reconsideration is requested in view of the following comments.

Still further, claim 12 is rejected under 35 USC 103(a) as being unpatentable over Switzerland CH 237277, US 1,907,196 to Aitken, and US 3,866,618 to Tsukamoto. This rejection is respectfully traversed and reconsideration is requested in view of the following comments.

Still further, claims 19 and 23 are rejected under 35 USC 103(a) as being unpatentable over Switzerland CH 237277, US 1,907,196 to Aitken, and US 4,785,835 to Bray. This rejection is respectfully traversed and reconsideration is requested in view of the following comments.

Still further, claims 20 and 22 are rejected under 35 USC 103(a) as being unpatentable over Switzerland CH 237277, US 1,907,196 to Aitken, and US 4,497,694 to Bankier et al. This rejection is respectfully traversed and reconsideration is requested in view of the following comments.

Applicant respectfully submits that the claims are patentable over the cited prior art. The nail file, which is the subject of the invention defined in claims 1, 21 and 26, is simply not suggested by the prior art.

CH 237277 discloses a file made from a vitreous material, such as glass, with teeth cut into it. Applicant emphasizes the clear and exclusive disclosure of teeth in CH 237277. Applicant references page 1, paragraph 4 of the translation, wherein it is disclosed that "a series of parallel teeth" are cut into a sheet of glass. Similarly on page 2, paragraph 1 (continued from page 1) it is disclosed that "file teeth are cut" into a layer of enamel.

Aitken discloses a sand blasting process that is used to sharpen a toothed tool, such as a file (page 1, lines 65-68). The process is used to produce or restore the cutting edges of the teeth (page 1, lines 69-72). The effects of the sand blasting occur mainly at the outer tooth surfaces (page 1, lines 14-16; page 2, lines 39-45). There is no disclosure that any portion of the file other than the outer tooth surfaces is affected by the sand blasting. Further, it is to be noted that the process in Aitken relies upon the pre-existence of teeth; the process is not used to create teeth.

Claim 1

Claim 1 recites a nail file having a body with first and second sides, first and second edges, a first end, and at least one abrading surface, all of which are formed of a single, integral stratum of glass. In addition, claim 1 recites that the abrading surface of the file is a sanded and/or acid-etched surface. Applicant has previously discussed the structural differences and functional advantages of an acid-etched or sanded surface compared to a series of cut teeth (see the Amendment filed August 6, 2001), which are not repeated herein in their entirety.

However, one structural difference is that a sanded surface or an acid-etched surface, as these terms are defined by Applicant in the specification (see e.g. page 3, lines 9-12), has an essentially random texture. That is, the surface has a more or less random structure of peaks and valleys. The Examiner has argued that sanding or etching does not necessarily provide a random texture. Although this is likely true, as defined by Applicant in the specification the terms "acid-etched surface" and "sanded surface" refer to a surface with a random texture produced by an acid-etching or sanding process that does result in a random surface texture. An Applicant is allowed to be his own lexicographer. In this case, Applicant has chosen to recite "acid-etched

"surface" and "sanded surface", which is a substitute way of reciting random surface. The surfaces in CH 237277 and Aitken are not random.

Further, the rejection to claim 1 indicates that the specific process is not given patentable weight in an article claim. Applicant is not claiming just the process. Rather, as discussed in the preceding paragraph, Applicant is claiming the surface, in this case a random surface, that results from acid-etching or sanding.

However, there is nothing wrong with defining a claimed product in terms of the process by which it is made. MPEP 2173.05(p). Further, while patentability may rest primarily on the product itself, in order to properly reject such a claim, the claimed product must be shown to be the same as or similar to a prior art product. MPEP 2113. As discussed above, "acid-etched surface" and "sanded surface" refers to a surface that has a random texture. The surfaces in CH 237277 and Aitken are not in any way similar to Applicant's disclosed and claimed surface.

As a result, CH 237277 and Aitken, taken singly or in combination, do not suggest the invention recited in claim 1.

Claim 21

Claim 21 recites a method of making a nail file, wherein a glass body is roughened by sanding and/or acid-etching to produce at least one abrading surface. The patentability of this claim needs to be determined separately from the patentability of claim 1.

CH 237277 discloses cutting teeth into a sheet of glass in a nail file. Aitken teaches using sand blasting to produce or restore the cutting edges of teeth on a file. Neither reference teaches using acid-etching or sanding to roughen a glass body to produce an abrading surface. At best, Aitken would suggest a process by which the teeth in CH 237277 could be restored or sharpened. However, the sand blasting process in Aitken does not roughen, as this term is defined by Applicant in the specification. The sand blasting process disclosed by Aitken removes material from pre-existing teeth to restore the sharpness of the teeth. The end result of the Aitken process is not rough surfaces where sand blasting occurs. Rather, the surfaces that are subject to sand blasting are smooth (see Figure 8). The Examiner's own comment that sanding or etching does not necessarily provide a rough or random texture is exemplified in Aitken.

CH 237277 and Aitken simply do not suggest using acid-etching or sanding for roughening a glass body to produce an abrading surface.

For at least the reasons discussed above, claims 1 and 21 are patentable over CH 237277 and Aitken, and withdrawal of the rejection is requested. Claims 2-18, 24 and 25 depend from either claim 1 or claim 21, and incorporate the limitations thereof. Therefore, the dependent claims are patentable along with claims 1 and 21 and need not be separately distinguished. Applicant does not concede the correctness of the rejections to the dependent claims, and reserves the right to present additional arguments rebutting the rejections.

Claim 26

Claim 26 recites a nail file having a body with first and second sides, first and second edges, a first end, and at least one abrading surface, all of which are formed of a single, integral stratum of glass. In addition, claim 1 recites that the abrading surface of the nail file comprises an irregular texture resulting from a process selected from the group consisting of acid-etching and sanding.

The surfaces in CH 237277 and Aitken do not have irregular textures, let alone irregular textures that result from acid-etching or sanding. The teeth in CH 237277 are in an orderly, parallel linear arrangement; no surface has an irregular texture. Likewise, the teeth in Aitken are in an orderly, parallel linear arrangement. The result of the sand blasting in Aitken is to increase the orderly nature of the teeth by restoring the cutting edges. No surface has an irregular texture.

Because neither reference teaches a surface having an irregular texture, the proposed combination of CH 237277 and Aitken does not render obvious the invention recited in claim 26.

Conclusion

Applicants believe that the application is in condition for allowance. Favorable consideration is respectfully requested. If any further questions arise, the Examiner is invited to contact Applicants' representative at the number listed below.

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